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PATENT



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#7  
J.G.  
8/14/01

In re application of: Clark

Serial No.: 09/504,280

Group Art Unit: 1647

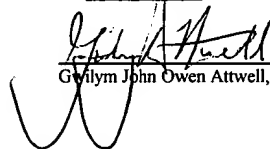
Filed: February 15, 2000

Examiner: D. Romeo

For: **MODIFIED TUMOR NECROSIS FACTOR**

I, Gwilym John Owen Attwell, Registration No. 45,449 certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

On August 6, 2001

  
Gwilym John Owen Attwell, Registration No 45,449

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

**RESPONSE**

This paper is filed in response to the Office Action dated June 6, 2001. The period to respond is extended by payment of the appropriate fee, provided herewith.

Claims 1-23, all the pending claims, are subject to a restriction requirement.

The Examiner required Applicant to elect one of the following patentably distinct inventions for examination:

Invention I, encompassing claims 1-4 and 9-17, "to the extent that they are drawn to a modified TNF- $\alpha$  wherein the modified TNF is a mutated TNF comprising a lysine to alanine mutation, and a method of making same, classified in class 530, subclass 402";

Invention II, encompassing claims 1-8 and 14-17, "to the extent that they are drawn to a modified TNF- $\alpha$  wherein the modified TNF is a non-mutated or deleted TNF, and a method of making same, classified in class 530, subclass 402";

Invention III, encompassing claims 18-23, "to the extent that they are drawn to a method of inhibiting tumor growth with a modified TNF- $\alpha$  wherein the modified TNF is a mutated TNF comprising a lysine to alanine mutation, classified in class 514, subclass 12"; and

Invention IV, encompassing claims 18-23, "to the extent that they are drawn to a method of inhibiting tumor growth with a modified TNF- $\alpha$  wherein the modified TNF is a non-mutated or deleted TNF, classified in class 514, subclass 12".

(Office Action at page 2).

The Office Action alleges that each of the inventions is distinct because, *inter alia*, "neither member of a pair is required for the production or use of the other, and wherein each of the pair can be manufactured independently of the other and/or used for independent and distinct purposes: I and II." (Office Action at pages 2-3). Additionally, "[t]he following pairwise combinations of methods are independent and distinct, wherein each member of a pair performs different functions, using different starting materials and/or process steps: II and IV." (Office Action at page 4).

The Office Action further requires the election of a single disclosed species selected from the patentably distinct species of the claimed invention, "the linkers in claim 3 or 4."

Applicant provisionally elects herein Group II encompassing claims 1-8 and 14-17, "to the extent that they are drawn to a modified TNF- $\alpha$  wherein the modified TNF is a non-mutated or deleted TNF, and a method of making same, classified in class 530, subclass 402. Applicant provisionally elects succinimidyl succinate (SS) from the patentably distinct species set forth in claims 3 and 4. Of the claims comprising elected Group I, claims 1-8 and 14-17 read on the use of succinimidyl succinate as the linker.

Notwithstanding the foregoing, Applicant respectfully submits that the four groups of claims set forth by the Examiner are amenable to further grouping and that such further grouping would not impose a serious burden on the Examiner.

The examination of these claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at (215) 564-8338 to clarify any unresolved issues raised by this response.

Respectfully submitted,



Gwilym John Owen Attwell

Registration No. 45,449

Date: August 6, 2001  
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